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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,068	01/28/2004	Soichi Saito	WAKAB85.001AUS	2422
20995 7590 04/11/2008 KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614				
EXAMINER				
OLSEN, KAJ K				
ART UNIT		PAPER NUMBER		
1795				
NOTIFICATION DATE		DELIVERY MODE		
04/11/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com
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Office Action Summary

Application No.

10/766,068

Applicant(s)

SAITO ET AL.

Examiner

KAJ K. OLSEN

Art Unit

1795

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-11 and 14-20 is/are allowed.
- 6) ☒ Claim(s) 12, 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The examiner has withdrawn all outstanding 112 rejections of the claims in view of the amendment of 1-28-2008.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inamoto et al (USP 5,352,349) in view of Cozzette et al (USP 5,112,455).

4. Claims 12 and 13 remain rejected over the teachings of Inamoto and Cozzette for the reasons set forth in the previous office action. Applicant has amended each of these claims to recite that the notification device is used for a procedure having a number of limitations from the preceding method claims. Although the examiner was persuaded that the combined teachings of Inamoto and Cozzette no longer read on the defined method claims (see discussion below), these apparatus claims do not free of the teachings of Inamoto and Cozzette because a number of these procedure steps do not actually further define the structure of the notification device, but merely recite how the structure is to be utilized. In particular, the only structural feature that appears to be necessary for the notification device for this procedure is a means for applying a first initial or

refresh treatment bias having the same direction as the measurement bias and a second initial or refresh treatment bias that is the same as the measurement bias. Inamoto teaches a circuit that can apply a voltage (1 V) that is in excess of the measurement bias (0.75 V) and is in the same direction as the measurement bias (see time period R2 in fig. 3A), and follows this with a applicant of a measurement bias (0.75V in fig. 3A). In other words, Inamoto sequence of R2 and the time following R2 is analogous to the sequence relied on by the instant invention. Compare fig. 3 of the instant invention with the combination of R2 and the period following R2 in fig. 3A of Inamoto. Hence, the structure already disclosed by Inamoto would be capable of performing the procedure of the instant invention. The main differences between the instant invention sequence and the sequence of Inamoto is the applicant's lack of use of reverse voltage step and the use of a buffer solution for the first and second initial treatment steps followed by placing the sensor into the measurement sample. With respect to the choice of solutions utilized for this combination of high bias followed by the measurement bias, this doesn't further define the actual notification device itself but merely sets forth how the operator of the sensor is going to manipulate the sensor in parallel with the notification device. With respect to the lack of a reverse voltage step, the apparatus claims do not state that the notification device cannot have this additional capability. Moreover, because the control section of Inamoto is entirely able to control which voltages are applied and for how long, the structure of Inamoto is already capable of omitting this reverse voltage application is it were so desired. Hence, the structure of Inamoto would be capable of performing the procedural steps set forth in claims 12 and 13 and these claims still read on the combination of Inamoto and Cozzette as set forth in the previous office action. The remaining procedural steps that do not define any particular structure for the

notification device are deemed to be the intended use of the device and the intended use need not be given further due consideration in determining patentability.

Allowable Subject Matter

5. Claims 1-11 and 14-20 are allowed.
6. The following is a statement of reasons for the indication of allowable subject matter:
The examiner was persuaded by applicant's arguments that the first initial treatment bias or first refresh treatment bias reads free of the procedure of Inamoto because the first treatment step of Inamoto concerns the use of a bias that is opposite that of the measurement bias in clear contradiction to the procedure set forth in the claims 1 and 11.

Response to Arguments

7. With respect to claims 1-11 and 14-20, applicant's arguments were persuasive and the examiner has withdrawn those outstanding rejections. With respect to the arguments concerning claims 12 and 13, those arguments appear to rely on the issues raised for the method claims. However, as the examiner discussed above, it is unnecessary for the prior art to teach the set forth procedure as long as the prior art has structure that would have been capable of performing the set forth procedure. Claims 12 and 13 thereby remain rejected over the teachings of Inamoto and Cozzette.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KAJ K. OLSEN whose telephone number is (571)272-1344. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam X. Nguyen can be reached on 571-272-1342. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1795

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kaj K Olsen/
Primary Examiner, Art Unit 1795
April 9, 2008